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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants: Johan ULIN, et al.
Appl. No.: **10/539,045**
Filed: March 6, 2006
Conf. No.: 7386
Group: 1772
Examiner: Dennis Michael White
For: VESSEL FOR PERFORMING MICROWAVE-ASSISTED
CHEMISTRY ON SMALL VOLUMES OF REAGENTS
Atty. Dkt. No.: 12090-000016/US

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APPELLANTS' REPLY BRIEF UNDER 37 C.F.R. § 41.41

In response to the Examiner's Answer of March 9, 2011, and in accordance with the provisions of 37 C.F.R. § 41.41, Appellants submit the following Reply Brief.

I. STATUS OF CLAIMS

Claims 15-29 are currently pending in the present application, of which claims 15 and 29 are the independent claims on appeal.

Appellants respectfully request the designated panel of examiners (Panel) to review the rejection of claims 15-21 and 23-29 under 35 U.S.C. § 103(a) as being unpatentable over Jennings ("Jennings"), U.S. Patent Publication No. 2002/0101310 in view of Commarmot et al. ("Commarmot"), U.S. Patent No. 4,693,867; and the rejection of claim 22 under 35 U.S.C. § 103(a) as being unpatentable over Jennings in view of Commarmot, and further in view of Bennett et al. ("Bennett"), U.S. Patent No. 5,520,886.

II. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

A. Appellants seek the Board's review of the rejection of claims 15-21 and 23-29 under 35 U.S.C. § 103(a) as being unpatentable over Jennings ("Jennings"), U.S. Patent Publication No. 2002/0101310 in view of Commarmot et al. ("Commarmot"), U.S. Patent No. 4,693,867.

B. Appellants seek the Board's review of the rejection of claim 22 under 35 U.S.C. § 103(a) as being unpatentable over Jennings in view of Commarmot, and further in view of Bennett et al. ("Bennett"), U.S. Patent No. 5,520,886.

III. ARGUMENTS

In addition to the arguments articulated in the Appeal Brief of December 23, 2010, Appellants would like to note the following points. However, it should be understood that any portion of the Examiner's Answer that is not specifically addressed herein is not a concession as to the propriety of that portion. Rather, the absence of a specific reply to such a portion is merely because clarification was not needed in view of the arguments already articulated in the Appeal Brief of December 23, 2010.

In the Examiner's Answer of March 9, 2011, in the "Response to Argument" section, the Examiner asserts that "the collet assembly 91 contacts the septum 134 at 106 ("extending over the diaphragm") and further extends over the attenuator 33 at **107** ("extending over the sleeve")."¹ In other words, the Examiner contends that the portion where the collet leaves **107** contacts the threaded portion of the attenuator 33, corresponds to the "cap" member of claim 15 that "extends over the diaphragm and the sleeve." Appellants respectfully disagree.

Specifically, Appellants submit that the collet leaves 107 of Jennings do not include a "**through hole**." Referring to *page 6, lines 14-18* in the instant specification; and *FIG. 2*, the cap 40 is formed with a through hole 41 that is positioned to match the mouth 14 of the reaction vessel 10 in the assembled relation. Further, the cap may be a metal element that may be secured about the perimeter of the sleeve 20, reaching "*over*" the outer boundary of the end plane 21.

¹ Examiner's Answer mailed March 9, 2011, page 10, 3rd full paragraph.

In contrast, in paragraph **[0060]** of Jennings, it states:

.....FIG. 9 shows that the transducer assembly 38 includes a plurality (four are preferred) of collet leaves 107. The leaves 107 are held in flexible relationship to the collet trunk 110 by the garter spring 111. Among other features, the collet trunk 110 includes a plurality of pins 112. As a result, when the leaves 107 are attached to the collet trunk 110 by the garter spring 111, the leaves 107 can flex inwardly and outwardly with respect to the overall axis of the assembly 38. Each leaf 107 further includes a gripping edge 113 that engages a cap on a vessel in a manner that is illustrated in FIG. 11....(emphasis added)

Contrary to the Examiner's assertion, the collet leaves 107 of Jennings do not include a "through hole." The collet leaves 107 of Jennings are merely "individual" parts that are attached to the trunk 110 which can each flex inwardly or outwardly with respect to the overall axis of the assembly 38. In other words, each collet leaf 107 is "separately" attached to the trunk 110 that flexes inwardly and outwardly to engage the attenuator.

However, one skilled in the art would appreciate that a "**through hole**" refers to a hole that is, for example, *reamed, drilled, milled*, etc., completely through the substrate - i.e., a through hole is a hole that goes all the way through something. See *In re Am Acad. Of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004), in which claims are given their broadest reasonable interpretation "in light of the specification as it would be interpreted by one of ordinary skill in the art." See also *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), in which "[w]ords of a claim are generally given their plain meaning;" and *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314, 75 USPQ2d 1321, 1327 (Fed Cir. 2005) (*en banc*), in which "[t]he plain meaning of a word may be evidenced by the claims, the specification and extrinsic evidence such as a dictionary."

Claim 15 provides that the cap has a “**through hole**.” Using the plain, ordinary meaning of “through hole,” one of ordinary skill in the art would acknowledge “**through hole**” is a hole that goes all the way through something. This interpretation is consistent with the specification - *see e.g., page 6, lines 14-18* in the instant specification.

Therefore, the Examiner's interpretation of “the collet leaves” 107 as corresponding to the “cap” member of claim 15 is not consistent with the *instant specification* as it would be interpreted by one of ordinary skill in the art.

Furthermore, in the Examiner's Answer of March 9, 2011, in the “Response to Argument” section, the Examiner acknowledges that Jennings does not disclose the claimed “widening portion being received in a corresponding recess formed in an end plane of the sleeve.”² Nevertheless, the Examiner attempts to justify that it would have been obvious to just merely substitute the sleeve 86 of Commarmot with the attenuator of Jennings. Appellants respectfully disagree.

The Examiner's rationale is purely clichéd and appears to just be a mere guise for *hindsight* reasoning. It is well-established that the test for obviousness is not whether a particular modification could have been made. Rather, the Examiner must show that, objectively, a person ordinarily skilled in the art would have been motivated to engage in a particular modification and/or combination and that the result would actually be one upon which the claims would read.³ As articulated in the Appeal Brief of December 23, 2010, establishing motivation requires the Examiner to demonstrate why one of ordinary skill in the art, absent the teachings of Appellants' application,

² Examiner's Answer mailed March 9, 2011, page 11, first full paragraph.

³ *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007).

would want to substitute the sleeve member of Commarmot with the attenuator member of Jennings. As previously argued, Commarmot discloses a cover 90 in abutment on the upper edge of ring 88 including a tube 95 in permanent relation with a supply pipe leading to a pumping and suction unit (*see col. 8, lines 40-50*). The pumping and suction unit is started up in synchronized manner necessary for ensuring removal of the fumes and vapors released by the reaction (*see, e.g., col. 10, line 35-42*). Accordingly, if one were to combine the two references, it follows that there cannot be any diaphragm (as taught by Jennings) in the apparatus according to Commarmot because a diaphragm would keep such fumes/vapors in the reaction vessel and the suction unit would not be able to remove the fumes/vapors.

Even for sake of argument that one of ordinary skill in the art may substitute the sleeve member 86 of Commarmot with the attenuator member 33 of Jennings, it would require a substantial reconstruction and redesign as well as a change in the basic principle under which Jennings was designed to operate. For instance, attempting to "widen" the attenuator 33 ("sleeve") of Jennings so as to receive the corresponding upper end of the tube in an end plane of the sleeve, one skilled in the art would be discouraged to do so. Specifically, widening the connection between the attenuator 33 and collet leaves 107 in Jennings would produce an *inoperable* device, due to the fact that the connection between the collet leaves 107 and the attenuator 33 requires a "*threaded*" connection. Therefore, it will be difficult to modify or redesign the attenuator of Jennings, without destroying the reference.

In view of the above, Appellants respectfully submit that one of ordinary skill in the art would not have combined the teachings of Commarmot with the teachings of Jennings in the manner used to reject the claims, and that the proposed combination

of Jennings and Commarmot, individually or in combination, fails to teach or suggest all of the elements of claim 15. Thus, no *prima facie* case of obviousness has been established. Accordingly, claim 15 is allowable over Jennings in view of Commarmot. Dependent claims 16-28 depend from claim 15 and are allowable for at least the reasons that claim 15 is allowable. Claim 29 is allowable for the similar reasons as discussed above regarding claim 15. Therefore, Appellants respectfully request that the rejection of claims 15-29 under 35 U.S.C. § 103(a) be favorable reconsidered and withdrawn.

IV. CONCLUSION

For at least the reasons above, a *prima facie* case of obviousness cannot be established with regard to claims 15-29. Accordingly, Appellants respectfully requests the Board to reverse the Examiner's rejection.

If the USPTO believes that a personal communication will further the prosecution of this application, the Office is invited to contact the undersigned, at the telephone number below.

The Commissioner is authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY, & PIERCE, P.L.C.

By: _____

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